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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,891	10/28/2003	Craig Wojcieszak	244709US17	4039
22850	7590	07/13/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			PHAN, THANH S	
			ART UNIT	PAPER NUMBER
			2841	

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/693,891

Applicant(s)

WOJCIESZAK, CRAIG

Examiner

Thanh S. Phan

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 April 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1- 5, 8-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Will [US 5,477,508].

Regarding claims 1, 2, 3, 8, 9 and 19, Will discloses an electronic device [digital watch] comprising; a watch case [1]; a relatively small display [2]; an electronics module [not explicitly labeled; figure 3a] contained by said case and including at least a processor [20] and a memory [21, 22] configured to store a plurality of available mode settings for the electronic device; and three or fewer selection buttons as input mechanism [4] configured to provide input commands to said processor, wherein said processor is configured to, based on said input comments, configure said electronic device to provide a custom mode setting for a subset of the plurality of available modes [figures 9-13].

Regarding claim 4, Will further discloses wherein said module further comprises a crystal oscillator [17 and 18] that provides digital timing inputs to the processor.

Regarding claim 5, Will further discloses wherein the input mechanism comprises at least one selector button [4].

Regarding claim 10, Will discloses wherein said available modes comprise an alarm mode [figure 1].

Regarding claim 11, Will discloses a lamp button [28; figure 3b] to turn on lamp [29] to illuminate the display.

Regarding claim 12, Will discloses wherein said input mechanism is configured to provide a reset of the electronic device to clear at least one setting of the electronic device [figure 10g]

Regarding claim 18, as the examiner interpreted the claim as mentioned above, Will discloses a computer-readable medium [not explicitly labeled; however, RAM 21 and ROM 22 is capable of performing the claimed function] containing program instructions for execution on a processor [figure 3a].

Regarding claims 13-17, the method steps are inherent to the disclosed apparatus structures.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Will in view of Portmann et al. [US 4,024,678].

Regarding claim 6, Will discloses the claimed invention except for the input means comprises three buttons.

Portmann et al. disclose an electronic watch comprise three push-buttons [A, B and C] as input means.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the input means of Will with the three buttons of Portmann et al. for the purpose of controlling chronograph functions.

Regarding claims 7, Will and Portmann et al. discloses the claimed invention except for labeled the three buttons as mode button, start/lap button, and a stop/reset button.

The examiner takes official notice that it is known in the art to label buttons according to their functions. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have the three buttons as mode, start/lap and stop/reset button for the purpose of indicating their functionality.

### ***Response to Arguments***

Applicant's arguments filed 04/27/05 have been fully considered but they are not persuasive. Applicant has argued that Will fails to teach the limitations as in claims 1, 13 and 19. Applicant emphasizes that [1] Will does not disclose that some of the menu items can be disabled to provide a custom watch that is simplified for particular users. [2] Will does not disclose a device configured to, based on the input commands, configure said electronic device to provide custom mode setting for a subset of the plurality of available modes. [3] Will does not disclose operating the input mechanism to toggle the selected mode on or off. [4] There are no motivations to combine Portman et al. with Will.

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The Examiner disagrees, as stated in the above rejections, Will alone and/or in combination disclose such invention. Regarding [1] and [3], Will discloses various menu items wherein the chosen functions are custom to that particular user, and the non-chosen functions are not activated; therefore it is being disabled. Regarding [2] the device must be electrically configured, see figures 3a-b and the description in the specification, otherwise the input commands would not be processed or performed. Regarding [4] In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Will and Portman et al. disclose inventions regarding timing devices, therefore such modification to enhance a timepiece would have been obvious to one ordinary skill in the art.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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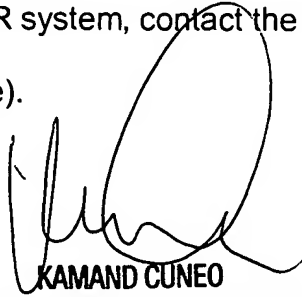
mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh S. Phan whose telephone number is 571-272-2109. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamand Cuneo can be reached on 571-272-1957. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tsp



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